## REMARKS/ARGUMENTS

This is in response to the Office Action of December 11, 2007. Claims 1-12 and 17-20 remain in this application. Reconsideration and allowance of the instant application are respectfully requested. We appreciate the Examiner's review of the previous filing. No new matter is added.

*Claims 1-12 are Believed Allowable over the '518 Patent and Naoyuki*

Claims 1-12 were allegedly rejected under 35 U.S.C. 103(a) under a combination of U.S. Patent No. 6,075,518 and Naoyuki (JP 2000-200147). The rejection is respectfully traversed.

Applicants disagree with the Office Action broad characterization of the '518 Patent. The '518 Patent has microswitches 34 which work on **depression** or a **depressing** the switches. There is no tensile force sensing with these microswitches. While the Office Action alleges that item 32 are sensors, it is clear these springs provide no sensing function at all. The patent is missing an element of the claim or clearly teaches away from the invention of claim 1. See the text below from the '518 Patent.

> similar device. The actuating assemblies **30** have resilient members **32** disposed thereunder for returning the support arm **20** to a neutral position relative to a base surface. In one embodiment, the resilient members **32** are helical springs, although other devices providing a return mechanism to the support arm **20** could be used. Alternatively, one resilient member could be disposed at the fulcrum point **22** for returning the support arm to the neutral position.

'518 Patent, Col. 3, lines 29-34

There is **no extension force** based sensing in this patent as alleged in the Office Action.

> switches could also be used. When the support arm **20** is pivoted a desired amount about the fulcrum point **22**, the actuating members **36** mechanically activate the micro switches **34**. The helical springs **32**, the micro switches and respective actuating members **34**, **36** are positioned and sized such that the helical springs **32** do not interfere with the contact of the switches and actuating members **34**, **36**.

"518 Patent, Col. 3, lines 40-47 (emphasis added)

**Clearly, the discussion in the '518 patent is teaching away from the invention of applicants**. See *KSR Int'l v. Teleflex, Inc.,* 550 U.S. (2007), Slip Op. 04-1350 *citing United States v. Adams*, 383 U.S. 39, 51-52 (1966) ("**when the prior art teaches away from combining certain know elements, discovery of a successful means of combining them is more likely to nonobvious**.").

Naoyuki merely discloses a scroll wheel and a stick but respectfully fails to teach or suggest scrolling an image in a second direction responsive to a detected extension force. Indeed, Naoyuki fails to teach or suggest an extension force at all. See *KSR Int'l v. Teleflex, Inc.,* 550 U.S. (2007), Slip Op. 04-1350 *citing United States v. Adams*, 383 U.S. 39, 51-52 (1966) ("when the prior art teaches away from combining certain know elements, discovery of a successful means of combining them is more likely to nonobvious.").

It is respectfully submitted that claim 1 is allowable over the cited references.

Claims 2-8 depend from claim 1 and are allowable for at least the reasons set forth above for claim 1. Therefore, withdrawal of the rejection is respectfully requested.

Claim 9, recites among other features, sensing **one of a first tensile force** and a **second tensile force** based on the lateral pressure applied to the rotatable member, the second tensile force being greater than the first tensile force; and scrolling the image on the display screen in an approximately horizontal direction on the display screen, wherein the scrolling is at a first rate responsive to sensing the first tensile force and at a second rate responsive to sensing the second tensile force, the first rate being less than the second rate.

The '518 Patent does not teach or suggest a **first tensile force** or **a second tensile force** based on the lateral pressure applied to the rotatable member, the second tensile force being greater than the first tensile force. Indeed, the '518 Patent fails to teach or suggest a **tensile force at all for scrolling**. When evaluating patentability under 35 U.S.C. § 103(a), all claim limitations must be considered, especially when they are missing from the prior art. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988) (Federal Circuit held a reference did not render the claimed combination obvious because the examiner ignored a claimed limitation that was absent from the reference). Additionally, the '768

Patent and Naoyuki fails to teach or suggest the recited features of wherein the scrolling is at a first rate responsive to sensing the first tensile force and at a second rate responsive to sensing the second tensile force, the first rate being less than the second rate.

Claims 10-12 depend from claim 9. Therefore, it is respectfully submitted that the rejection of claims 9-12 should be withdrawn.

*Claim 17-20 are Allowable over the '768 Patent and Naoyuki*

Claims 17-20 were allegedly rejected under 35 U.S.C. 103(a) under a combination of U.S. Patent No. 6,555,768 or Pruchniak, and Naoyuki (JP 2000-200147) and U.S. Patent No. 6,016,110. The rejection is respectfully traversed.

Regarding claim 17, the '768 Patent fails to teach or suggest various features. The '768 Patent or Pruchniak, either alone or in combination with Naoyuki, fails to teach or suggest claim 17.

The '768 Patent has contacts 8 and 9 which work on **depression** or a **depressing** the contacts. The patent is missing an element of the claim or clearly teaches away from the invention of claim 17. See the text below from the '768 Patent.

> Two actuator contacts (8 and 9) are positioned below the roller member and depressing corresponding parts of the roller member activates either or both contacts.
>
> It is an essential aspect of the present invention that the roller key in excess of the navigation possibilities in rolling or scrolling, provides switch signal outputs corresponding to at least four different logic states, as illustrated in Table 1 below. This is achieved by having at least two actuator contacts, which can be depressed individually or simultaneously by depressing corresponding parts of the roller member.

"768 Patent, Col. 5, lines 56-68

The '768 Patent also fails to teach or suggest a sensor positioned within said housing for sensing a period of time of lateral displacement of the rotatable member based on a tensile force or a signal to scroll the image across the display screen at a first speed if the period of time is less than or equal to a predetermined period of time, otherwise scrolling the image at a second speed, the second speed being greater than the

first speed as recited in claim 17. For similar reasons discussed above, there is no extension or tensile force detections for scrolling images in the 768 patent and Pruchniak.

There is no teaching in the '768 Patent, nor any suggestion of scrolling an image in a left or right direction. The '768 Patent is completely silent as the scrolling in the left and right direction. Claims 18-20 depend from claim 17 and are allowable for at least the reasons set forth above for claim 17.

## CONCLUSION

It is believed that no fee is required for this submission. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

All rejections having been addressed, applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same.

Respectfully submitted,

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